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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,496	01/17/2007	Nathalie Picollet-D'Hahan	295393US2PCT	1075
22850 7590 01/15/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER YANG, NELSON C	
			ART UNIT 1641	PAPER NUMBER
			NOTIFICATION DATE 01/15/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/590,496

**Applicant(s)**

PICOLLET-D'HAHAN ET AL.

**Examiner**

Nelson Yang

**Art Unit**

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-54 is/are pending in the application.
- 4a) Of the above claim(s) 38-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-37 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/2/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of group I, claims 28-37, and 54 in the reply filed on October 12, 2007 is acknowledged.
2. Claims 38-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 12, 2007.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 28-37, and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. With respect to claim 28, 36, and 54, it is unclear how steps a), b), and c) can be carried out simultaneously, particularly since step c) cannot be performed without first performing step b), thus rendering the claims indefinite.
7. The remaining claims are indefinite due to their dependence on an indefinite claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 28-35, 37, and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirschfeld et al. [US 4,558,014].

With respect to claims 28, 54, Hirschfeld et al. teach a method comprising a fiber-optic waveguiding sensor (column 4, lines 40-65), wherein the fiber is immersed in a sample of interest for a sufficient time period for the tagged constituent to bind to an immobilized component (column 3, lines 55-60, column 4, lines 4-16). Hirschfeld et al. further teach that the fluorescence propagates within the fiber through total reflected fluorescence, exits the face at one end and collected by optics and projected through a splitter toward a detector wherein the fluorescence is measured by total reflection fluorescence (column 13, lines 15-30) and compared with the output from a reference detector (column 14, lines 18-46). The change in fluorescence would indicate binding of analyte and thus the position of the analyte.

10. With respect to claim 29, Hirschfeld et al. teach fluorescent tagged antigen (column 3, lines 59-61)

11. With respect to claim 30, Hirschfeld et al. teach coating of chemically bound protein (column 9, lines 20-30) and fluorescent material (column 8, lines 46-65).

12. With respect to claim 31, Hirschfeld et al. teach capillary tubes fabricated from glass (column 6, lines 35-45).
13. With respect to claims 32, 33, Hirschfeld et al. teach that the fluorescence propagates within the fiber through total reflected fluorescence, exits the face at one end and collected by optics (means for extracting light) and projected through a splitter toward a detector wherein the fluorescence is measured by total reflection fluorescence (column 13, lines 15-30).
14. With respect to claim 34, Hirschfeld et al. teach sealing the tube as soon as the sample is collected (column 14, lines 50-55).
15. With respect to claim 35, Hirschfeld et al. teach a through opening in the support (see figs. 1 and 2, bottom of the capillary tube). The sample would be drawn through the opening through capillary forces (thus creating a low pressure in the through opening).
16. With respect to claim 37, Hirschfeld et al. teach that cells may be detected (column 12, lines 3—40).

### *Conclusion*


17. No claims are allowed.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is (571) 272-0826. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nelson Yang  
Patent Examiner  
Art Unit 1641